that claims 2, 3 and 5-14 would be allowable if rewritten in independent form, and issued a new rejection of the remaining claims under 35 U.S.C. § 103(a) as being unpatentable over Kinjo '046 in view of Satou '254; this rejection has been withdrawn in the present Office Action (mailed August 9, 2006); in any event, Kinjo is **disqualified** as a reference under 35 U.S.C. § 103(a) because, in accordance with 35 U.S.C. § 103(c), Applicant states that Kinjo and the present application were commonly owned by the same assignee (Fuji Photo Film Co.) at the time the present invention was made.

**THE REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH**

As stated above, this rejection is substantially the same as the one made in the parent application, and the Examiner does not appear to take into consideration the amendments in the Preliminary Amendment (in the present application) to overcome this rejection, as the Examiner's quotation, "conveying means for conveying the original to be read…", is incomplete, because the involved limitation reads "control means for conveying means wherein…". If the Examiner still feels that this language is "indefinite", Applicant respectfully requests the Examiner to **call the undersigned attorney** to discuss the matter; for example, perhaps "wherein" could be changed to "so that". Thus, Applicant respectfully **traverses** the rejection of claims 1 and 16 under 35 U.S.C. § 112, second paragraph.

As for the rejection directed to lines 7, 8, 9 and 14 of claim 1, Applicant does not understand the Examiner's statement that, "There is insufficient antecedent basis for this limitation in the claim". The questioned claim elements in the specified lines are introduced for the first time in the involved lines (some with the indefinite article "a"), and therefore do not

have (and cannot have) an "antecedent basis". Therefore, Applicant respectfully requests the Examiner to reconsider and withdraw this ground of the rejection under 35 U.S.C. § 112, second paragraph, or else to discuss the matter with his supervisors and/or call the undersigned attorney to discuss the matter.

**THE REJECTION OF CLAIMS 1-19 UNDER 35 U.S.C. § 103(a) AS BEING UNPATENTABLE (OBVIOUS) OVER NAKAMURA '578 IN VIEW OF SATOU '254**

Applicant **again respectfully** traverses this rejection, and respectfully requests the Examiner to reconsider and withdraw the rejections.

In particular, the Examiner alleges that Nakamura discloses designating means for designating an image to be read among a plurality of images (see Office Action, page 4, third full paragraph). For at least the following reasons, Applicant respectfully disagrees with the Examiner's position and respectfully submits that the Examiner is mischaracterizing the Nakamura reference.

Applicant submits that Nakamura neither discloses nor suggests designating means for designating an image to be read among a plurality of images, as alleged by the Examiner. **Instead**, Nakamura **merely** discloses that an image sensor 22 reads an image positioned on the reading position by dividing it into a multiplicity of regions and separating it into three colors, which it then outputs as image data representing the density of the colors in each of the divided regions (see column 4, lines 53-60). Thus, Nakamura (at best) discloses dividing the image into regions and separating the colors in each region into three colors before it outputs image data for each region. However, Nakamura does **not** disclose or even suggest that the device designates

only a portion of the regions. On the **contrary**, Nakamura outputs image data for "each of the divided regions".

In comparison, claim 1 recites, *inter alia*, "designating means for designating an image to be read *among the plurality of images*" (emphasis added). Additionally, independent claim 16, recites, *inter alia*, that the image to be read "is *designated from among the plurality of images* recorded on the original to be read" (emphasis added).

Therefore, for at least the foregoing reasons, Applicant submits that the Examiner is mischaracterizing the Nakamura reference, and, thus, the asserted **combination** clearly does **not** disclose or even suggest all of the recitations of independent claims 1 and 16 (and dependent claims 2-15 and 17-19).

Additionally, the Examiner **concedes** that Nakamura does not disclose "control means for controlling the conveying means", as recited in independent claims 1 and 16. Therefore, the Examiner looks to Satou for this disclosure, and alleges that it would have been obvious to combine these references to arrive at the claimed invention.

In particular, the Examiner alleges that Satou makes up for the deficiencies of Nakamura by disclosing that the original to be read is conveyed at a speed greater than or equal to a conveying speed corresponding to a reading speed of the image to be read or a vicinity thereof, comes to be located at the predetermined reading position and that when reading the image to be read the original to be read is conveyed at a conveying speed corresponding to the reading speed for the image to be read (see Office Action, paragraph bridging pages 4 and 5). For at least the following reasons, Applicant **disagrees** with the Examiner's position and respectfully submits

that the Examiner is mischaracterizing the Satou reference. (In view of the Examiner's incomplete recitation of the involved claim language, Applicant submits that the Examiner may not be looking at the claims as amended in the Preliminary Amendment.)

Satou discloses an image reading device for a facsimile machine. Additionally, Satou discloses that it has been conventional practice to employ an acceleration drive to the facsimile machine, wherein the rotational speed of a stepping motor is increased in stages by starting from a slow speed and increasing in steps until a rated high speed is reached (see col. 1, lines 36-40). In particular, Satou relates to a device having three speeds for controlling the speed of the stepping motor that feeds the documents during each of three corresponding read control means. In other words, at each of the three speeds, the stepping motor feeds the document in a direction perpendicular to the direction in which the image scanner scans the document, such that the document is fed by the motor and scanned in synchronization. Thus, the device of Satou merely ramps up the speed from a starting speed to a rated high speed simply by starting at a lower speed and increasing in steps until it reaches the rated high speed. Correspondingly, the image scanner scans the device in synchronization with the stepping motor, based on the speed of the stepping motor, such that the image scanner scans only the data corresponding to the image of the document which is to be reproduced, thereby avoiding the necessity to discard data resulting from multiple scans of the same line.

However, **contrary** to the Examiner's position, Satou clearly does **not** disclose or suggest the claimed "control means for controlling" the speed of the original to be read, wherein the

conveying speed is greater when the image is not being read than it is when the image is being read. **Instead**, Satou merely speeds up the feeding motor in steps until it reaches a desired speed.

Therefore, Applicant submits that Satou **neither** discloses **nor** suggests "a control means for controlling the conveying means", as recited in claim 1. Similarly, Satou clearly does **not** disclose or even suggest conveying the original to be read "at a speed greater than a conveying speed corresponding to a reading speed of an image to be read which [image] is designated from among a plurality of images recorded on the original to be read, until a reading start position of the image to be read or a vicinity of the reading start position comes to be located at the predetermined reading position", as recited in claim 16. Accordingly, Applicant submits that Satou does **not** make up for the deficiencies of Nakamura.

For at least the reasons set forth above, Applicant believes that the Examiner is mischaracterizing the applied references. As such, Applicant submits that the Examiner has not established a *prima facie* case of obviousness at least with respect to independent claims 1 and 16.

Additionally, irrespective of the Examiner's characterization of the references, Applicant submits that the applied references do not disclose or suggest all of the individual elements of the claims. Therefore, Applicant does not even reach the analysis of whether a reasonable motivation exists to combine Nakamura and Satou to arrive at the claimed invention, since the combination of these references clearly cannot (and does not) disclose or suggest all of the recitations of independent claims 1 and 16. Thus, Applicant submits that any combination of Nakamura and Satou clearly would not (and could not) disclose or suggest at least either the

claimed "designating means for designating an image to be read among the plurality of images" or the claimed "control means for controlling the conveying means wherein the original to be read is conveyed at a speed greater than or equal to the conveying speed corresponding to a reading speed of the image to be read", as recited in independent claims 1 and 16, respectively.

Accordingly, Applicant submits that the Examiner has not established a *prima facie* case of obviousness, since neither Nakamura nor Satou, either alone or in combination, discloses or even suggests all of the recitations of independent claims 1 and 16 (and dependent claims 2-15 and 7-19); and thus, the §103 rejection of claims 1-19 over Nakamura and Satou should be withdrawn.

Therefore, Applicant respectfully requests Examiner Worku to reconsider and withdraw the rejection under 35 U.S.C. § 112, second paragraph, the objection to claim 1, and the rejection under 35 U.S.C. § 103(a), and to find the application to be in condition for allowance with all of **claims 1-19**; however, if for any reason the Examiner feels that the application is not now in condition for allowance, the Examiner is respectfully requested to **call the undersigned attorney** to discuss any unresolved issues and to expedite the disposition of the application. (In this regard, the parent application was filed on June 30, **1999**, and the parent and present continuation applications have already received **four non-final** Office Actions.)

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this application, and any required fee for such extension is to be charged to Deposit Account No. 19-4880. The Commissioner is also authorized to charge any additional fees

under 37 C.F.R. § 1.16 and/or § 1.17 necessary to keep this application pending in the Patent and Trademark Office or credit any overpayment to said Deposit Account No. 19-4880.

Respectfully submitted,

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